

REMARKS

Claims 14 to 17 are currently pending in the present application (since claims 18 to 33 were previously withdrawn as restricted).

In this regard, it is noted that the Office Action mistakenly referred in the April 21, 2003 Action to claims 14 to 16 as only being pending. That is, the April 21, 2003 Action mistakenly referred to claims 14 to 16 as being elected, when, in fact, claims 14 to 17 were elected in the March 24, 2003 response, according to the restriction requirement, WHICH PROVIDED THAT Group I, Species A covered claims 14 to 17 (see the original restriction requirement.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four (4) of the Final Office Action, claims 14 to 16 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,775,600 (“Wildeson et al.”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 14, as presented, relates to a fuel injector, including a valve needle, a fixed valve seat surface, a valve-closure member, a connecting piece, and a valve housing that at least partially encloses the connecting piece, *the valve housing being joined to the connecting piece by a crimped connection*, in which the connecting piece includes at least one notch, and in which *the valve housing, under an axial stress, is crimped into the at least one notch*.

While the rejections may not be agreed with, to facilitate matters, claim 14 (and claim 17 which was also previously elected) now provides that *the crimp connection is formed by the valve housing, which before it is crimped, has a material bulge protruding radially outwards which, to generate the axial stressing force between the valve housing and an inserted connecting piece, has an average distance d with respect to a notch at a circumference of the connecting piece, the crimped connection being formed from a shift of the material in a height of the material bulge of the valve housing inwards in the radial direction and all the way into the notch.*

In this regard, it is plain from claim 14, as presented, that its features are plainly disclosed by the present application, which specifically discloses that that the crimped connection is created by valve housing 20, before crimping, having a material bulge 70 that protrudes radially outwards (see Figure 2 and the related text), and which, to generate an axial stress between valve housing 20 and inserted connecting piece 1 has an average distance “ d ” with respect to notch 40 at the circumference of connecting piece 1. The crimping connection is generated by shifting the material in the height of material bulge 70 of valve housing 20 inwards in the radial direction all the way into notch 40. It is believed and respectfully submitted that the Wildeson reference does not identically disclose (or even suggest) the emphasized features of claim 14, as presented, so that claim 14 is allowable for these reasons alone.

In particular, as regards the Wildeson reference, it merely refers to a valve body shell 42 telescoped over a valve body 60 creating an interference fit preparatory to welding. (Wildeson, Abstract; col. 3, lines 4 to 9). To create an interference fit, Wildeson refers to a press-fit or a slip-fit, during which a bulge of material from either the valve body shell 42 or from the valve body 60 may be displaced into a groove. (Wildeson, col. 3, lines 25 to 36; col. 6, lines 18 to 26; col. 6, lines 45 to 54; col. 7, lines 12 to 20; col. 7, lines 51 to 56). Thus, Wildeson merely refers to press-fitting or slip-fitting the valve body shell and valve body together, during which some of the material from either component may be displaced, but it

does not even mention the feature of a crimped connection, or the feature that the valve housing is crimped into the at least one notch, as provided for in the context of claim 14.

Further, the Final Office Action states that “[a]ny process of crimping that may be implied by the recitation ‘crimped connection’ and ‘is crimped’ renders the claim a product by process claim. MPEP 2113.” (Final Office Action, p. 3). It is respectfully submitted that the features of “crimped connection” and “crimped” are structural limitations which result in a product wholly different than that indicated by the Wildeson reference. The press-fitting or slip-fitting steps of Wildeson are merely referred to as preparatory interference fits prior to final welding. Thus, the press-fitting or slip-fitting of Wildeson do not yield a final, completed product.

In contrast, the crimped connection of the presently claimed subject matter yields a final, completed product, without need for any further welding or subsequent joining steps. Further, the MPEP states “that terms such as ‘welded,’ ‘intermixed,’ ‘ground in place,’ ‘press fitted,’ and ‘etched’ are capable of construction as structural limitations.” *In re Garnero*, 412, F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). Therefore, it is respectfully submitted that the features of “crimped connection” and “crimped” are also structural features, as provided for in the context of claim 14 of the present application.

In addition, the Final Office Action states that “Wildeson teaches, in column 7, lines 40-50, ‘...to radially pull in the valve body shell 42A onto the diameter 116 of the valve body as shrinkage occurs.’” (Final Office Action, p. 3). It is respectfully submitted that the above text quoted in the Final Office Action refers only to the welding process is therefore irrelevant to the feature of a crimped connection, or the feature that the valve housing is crimped into the at least one notch, as provided for in the context of claim 14.

Therefore, Wildeson does not identically disclose (or even suggest) all of the features of claim 14, as presented, so that claim 14 is allowable. Claims 15 to 16 depend from claim 14, and are therefore allowable for at least the same reasons as claim 14.

Claim 17 includes features like those of claim 14, as presented, and is therefore allowable for essentially the same reasons.

Withdrawal of the rejections of the pending and considered claims is therefore respectfully requested.

Conclusion

It is therefore respectfully submitted that all of the presently pending and considered claims *14 to 17* are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

Dated: 4/17/2008

By: 

Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

33,865
Haran C
DEPT M)

CUSTOMER NO. 26646